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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,498	02/22/2002	Robert Fransdonk	5782P007	3732
21186	7590	08/11/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/082,498	Applicant(s) FRANSDONK, ROBERT	
	Examiner John M. Winter	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-28 and 31-43 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 29, 30, 44 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/18/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

STATUS

Claims 1-45 are pending.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Response to Arguments

The Applicant's arguments filed on May 24, 2006 have been fully considered.

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of licensing and therefore would be obvious to a person of ordinary skill in the art.

The applicant states that the cited prior art references fail to disclose the claimed features of :

Transmitting a license from a server to a secure device for storage, the license containing a product key of waterencrypted content and a client identifier.

transmitting via electronic network an entitlement control message containing content keys associated with said waterencrypted content to said secure device.

transmitting a request to provide a session content key from content key, said session content key to be used to decrypt said waterencrypted content.

The Examiner responds that as previously stated Narasimhalu et al. ('298) discloses via Figure 2, Column 5, lines 35-50 the feature of a license, the amended feature of *transmitting* the license data to a secure structure is further disclosed by figure 4 – specifically step 70 (write header and encrypted COIN onto medium) the examiner contends that this is analogous to the claimed feature of *Transmitting a license from a server to a secure device for storage*;

Narasimhalu et al. ('298) discloses via Column 6, lines 46-57; Figures 3 and 4, "an information output channel for transmitting re-encrypted information to the write device" the

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examiner contends that this is analogous to the claimed feature of *transmitting via electronic network an entitlement control message*

Colosso ('976) discloses *containing content keys associated with said watercrypted content* -- Column 13, lines 20-48, Colosso states that a key manager is queried and access is granted or denied based upon the result.

Narasimhalu et al. ('298) discloses via Column 7, lines 61-67; column 8 lines 1-23

The key is contained in the header of the COIN structure. The examiner contends that this is analogous to the claimed feature of *"transmitting a request to provide a session content key"*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 16-28 and 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al (US Patent 5,499,298) in view of Colosso (US Patent 6,169,976)

As per claim 1,

Narasimhalu et al. ('298) discloses

Transmitting a license from a server to a secure device for storage. (Figure 2, Column 5, lines 35-50 [the header of the COIN structure contains a signature field equivalent to a client identifier], figure 4)

transmitting via electronic network an entitlement control message containing content keys associated with said watercrypted content to said secure device (Column 6, lines 46-57; Figures 3 and 4)

receiving said session content key from said secure device in response to said request.

transmitting a request to provide a session content key from content key, said session content key to be used to decrypt said watercrypted content (Column 7, lines 61-67; column 8 lines 1-23)

Narasimhalu et al. ('298) does not explicitly disclose the license containing a product key of watercrypted content and a client identifier. Colosso ('976) discloses the license containing a product key of watercrypted content and a client identifier. (Column 13, lines 20-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the Narasimhalu et al. ('298) method with the Colosso ('976) method in order to prevent piracy of the media

Narasimhalu et al. ('298) discloses the claimed invention except for "plurality of content keys", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of content keys, since it has been held that mere

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duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 16 , 31 and 33 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,
Narasimhalu et al. ('298) discloses the method according to claim 1,
wherein said license is encrypted with a public key of said secure device to allow said secure device to access said license (Column 6, lines 1-14)

Claims 17 and 34 are in parallel with claim 2 and are rejected for at least the same reasons.

As per claim 3,
The method according to claim 1, wherein said license is encrypted with a secret key of said secure device to allow said secure device to access said license(Column 6, lines 1-14)

Claims 18 and 35 are in parallel with claim 3 and are rejected for at least the same reasons.

As per claim 4,
Narasimhalu et al. ('298) discloses the method according to claim 1,
further comprising establishing a secure channel to communicate securely with secure device (Figure 3, Column 7, lines 4-10)

Claims 19 and 36 are in parallel with claim 4 and are rejected for at least the same reasons.

As per claim 5
Narasimhalu et al. ('298) discloses the method according to claim 4, wherein said establishing further comprises:
encrypting a transport key with a personal public key, transmitting said transport key to said secure device(Column 6, lines 1-14)

Claim 20 and 37 are in parallel with claim 5 and are rejected for at least the same reasons.

As per claim 6
Narasimhalu et al. ('298) discloses the method according to claim 4, wherein said receiving further comprises:
Receiving said session content key encrypted with said transport key, decrypting said session content key to be used in decrypting said watercrypted content (Column 6, lines 1-14).

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Claims 21 and 38 are in parallel with claim 6 and are rejected for at least the same reasons.

As per claim 7

Narasimhalu et al. ('298) discloses the method according to claim 1 wherein said secure device is a smart card device (Column 6, lines 66-67; column 7 lines 1-10)

Claims 22 and 39 are in parallel with claim 7 and are rejected for at least the same reasons.

As per claim 8

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:
Receiving said license from a content server which distributed said watercrypted content (Column 6, lines 1-14)

Claims 23 and 40 are in parallel with claim 8 and are rejected for at least the same reasons.

As per claim 9

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:
Receiving said license from a content server which distributed said watercrypted content, said entity storing a client identifier and being configured to encrypt said product key with a public key of said secure device (Column 6, lines 1-14)

Claims 24 and 41 are in parallel with claim 9 and are rejected for at least the same reasons.

As per claim 10

Narasimhalu et al. ('298) discloses the method according to claim 1 further comprising:
Receiving said entitlement control message from a content server which distributed said watercrypted material (Column 6, lines 1-14)

Claims 25 and 42 are in parallel with claim 10 and are rejected for at least the same reasons.

As per claim 11,

Narasimhalu et al. ('298) discloses

Electronically storing a license containing a product key of a watercrypted content and a client identifier from a decoder.(Figure 2, Column 5, lines 35-50 [the header of the COIN structure contains a signature field equivalent to a client identifier])

receiving via electronic network an entitlement control message containing content keys associated with said watercrypted content from said decoder (Column 6, lines 46-50; Figure 3)

receiving a request to provide a session content key from content key, said session content key to be used to decrypt said watercrypted content, selecting said session content key

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using said product key and said client identifier from said license. (Column 7, lines 61-67; column 8 lines 1-23)

transmitting receiving said session content key from said secure device in response to said request.

Narasimhalu et al. ('298) discloses the claimed invention except for "plurality of content keys", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of content keys, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 16, 31 and 33 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 12

Narasimhalu et al. ('298) discloses the method according to claim 11 wherein said license is encrypted with a personal public key to allow access to said license (Column 6, lines 1-14)

Claims 27 and 43 are in parallel with claim 12 and are rejected for at least the same reasons.

As per claim 13

Narasimhalu et al. ('298) discloses the method according to claim 11 wherein said license is encrypted with a personal public key to allow access to said license (Column 6, lines 1-14)

Claim 27 is in parallel with claim 12 and is rejected for at least the same reasons.

Allowable Subject Matter

Claims 14, 15, 29, 30 44 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Reagan** can be reached at (571) 272-6710.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW
July 31, 2005

JAMES A. REAGAN
PRIMARY EXAMINER

